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Date Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
WANG and PABO
Serial No.: 09/636,243 Art Unit: 1627
Filing Date: August 10, 2000 Examiner: T. Wessendorf
Title: DIMERIZING PEPTIDES

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is filed in response to the Restriction Requirement mailed July 25, 2002, for which a response is initially due on or before August 25, 2002. Since August 25, 2002 falls on a Sunday, a response filed by Monday August 26, 2002 is considered timely. Accordingly, this response is timely filed.

The Examiner has required election of one of the following Groups of allegedly distinct inventions:

Group I Claims, 1-4, drawn to non-natural dimerizing peptide;

Group II Claims, 5-6, drawn to zinc finger complex (fusion protein);

Group III Claims, 7-14, drawn to a method of selecting dimerizing peptide by phage display library; and

Group IV Claims, 15-19, drawn to a method of detecting a target sequence.

Applicants provisionally elect Group II (claims 5 and 6), **with traverse**. For the following reasons, Applicants request that the restriction requirement be withdrawn.

It is well-settled that two criteria must be met for a proper restriction requirement under M.P.E.P. § 803: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Further, 37 C.F.R. § 1.141(b) clearly states:

> Where claims to all three categories, product, process of making, and process of use are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed of the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

Applicant respectfully submits that the Examiner has not met these burdens and has not shown that the inventions of Groups I-IV are 'distinct' under M.P.E.P. §

802.01 or 37 C.F.R. 1.141(b). In particular, the Examiner asserts that the inventions of Groups I and II have different structures. However, the Examiner then goes on to acknowledge that Groups I and II are both drawn to compositions comprising dimerizing peptides. (See, page 3 of the Restriction Requirement). Still further evidence as to the interrelatedness of these Groups is the fact that they are both classified in Class 530, subclass 324 or subclass 350 in the U.S. Patent Classification System. Accordingly, all claims of these Groups are subject to the same definitions, rules and, moreover, searches. Therefore, they should be examined together and it would not constitute an undue burden for the Examiner to do so. Indeed, examination of these allegedly distinct inventions in one application would not only not place an undue burden on the Examiner, but would actually save the Examiner time. In sum, as acknowledged by the Office, Groups I and II are related and should be examined together.

With regard to the product (Groups I and II) and process of selecting claims (Group III), the Examiner asserts that Groups (I and II) and Group III are unrelated because the claimed product (dimerizing peptide) "can be made by other chemical or biological means rather than by phage display library as claimed in Group III." (See, page 3 of the Restriction Requirement). Applicants note that the claims of Group III are not directed to methods of making the products of Group I and II. Rather, these claims are directed to methods of selecting such products. Accordingly, the burden is on the Examiner to show that the products of Groups I and II can be selected (not made) by "other chemical and biological means." No evidence has been presented to support this assertion and, in the absence of such evidence, the requirements of M.P.E.P. 803-805 have not been satisfied. Thus, since the process of selecting (Group III) is clearly related and directed specifically to the products (Groups I and II), Applicants submit that restriction as between these Groups is improper and should be withdrawn.

Turning to Group IV, Applicants reiterate that claims directed to process of using must be examined with related product and methods of making the product claims.

See, 37 C.F.R. § 1.141(b). Thus, even assuming, for the sake of argument only, that the process of using (Group IV) is "distinct" from the other Groups, it must be joined with these claims and examined together.

In sum, the Restriction Requirement of this application is improper because the Office has not met the two criteria of M.P.E.P. 803 and does not comply with the requirements of 37 C.F.R. § 1.141(b). Should the Examiner have any remaining issues, she is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: 26 Aug 2002

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